

REMARKS

At the time of the Final Office Action dated March 21, 2006, claims 1-4, 6-8, and 10-11 were pending in this application. Of those claims, claims 4, 7-8 and 11 have been rejected, and claims 1-3, 6, and 10 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

CLAIMS 4, 7-8, AND 11 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON CONKLIN ET AL., U.S. PATENT NO. 6,338,050 (HEREINAFTER CONKLIN), IN VIEW OF HORN ET AL., U.S. PATENT PUBLICATION NO. 2002/0156688 (HEREINAFTER HORN), AND FURTHER IN VIEW OF VEGA, U.S. PATENT PUBLICATION NO. 2002/0120554

On pages 4-8 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Conklin in view of Horn and Vega to arrive at the claimed invention. This rejection is respectfully traversed.

In the prior Amendment, Applicants argued that the combination of Conklin, Horn, and Vega fails to teach a single entity (i.e., the claimed "e-business complex") that performs both (i) managing certain sales functions for virtual store operators and (ii) brokering professional services to the virtual store operators. The Examiner responded to this argument on pages 2 and 3 of the Final Office Action. In particular, the Examiner stated:

The examiner respectfully disagrees because Conklin does teach managing sales functions for the participants, who could be either sellers or buyers or both and when they are both that implies that the Conklin's method and system is managing the same participant both sales function in selling his products and also selling products to the same participant (see Conklin col. 17, lines 19-21).

Applicants also argued that the disclosure of Conklin appears to be limited to products.

The Examiner responded to this argument by asserting:

The examiner respectfully disagrees because Conklin's method and system applies for both products as well services (see Conklin col. 19, lines 14-65 which disclose offering remote authoring services to sellers to create seller Websites). Therefore, it is clear that Conklin's system and method does suggest doing both function for a participant that is of managing selling their products and also providing services to the same seller such as creating a seller Website for them.

Applicants respectfully disagree with the Examiner's conclusion that "Conklin disclose[s] offering remote authoring services to sellers to create seller Websites." Remote authoring is described in column 19, lines 17-27 of Conklin, which is reproduced below:

Remote authoring 50, is a seller process which enables a registered seller in the community to create a seller Website within the community on which to include the seller's marketing and product information, along with pricing, terms, service offerings and so on. Information generated or created in this remote authoring process 50 is automatically integrated with the community databases and listings. Promotion and brand identifying actions (such as registering the Web page with search engines) are taken automatically on behalf of the seller as well.

Remote authoring is further described in column 20, lines 9-18, which are also reproduced below:

Web authoring 214-02, the present invention allows a seller registering with the sponsored community, to automatically create a seller's Website within the community, on completion of registration. The seller selects from several Website format templates provided by the present invention and as the seller "fills in the blanks" in a selected template, the information is automatically integrated with the rest of the system, so that orders can be processed and accepted immediately and more efficient registration with search engines is automatically initiated.

The limitations at issue with regard to these arguments are as follows:

providing to said store operators a catalog of professional services offered for sale by associated professional services providers; and,
brokering at least one transaction for at least one of said professional services between at least one of said store operators and at least one of said professional service providers.

At the outset, Applicants note that the "web authoring" described by Conklin is not a service provided by "associated professional services providers," as recited in the claims. Instead, the

"web authoring" is described by Conklin as an automated process which is performed upon a seller registering with the sponsored community, selecting a template, and filling in blanks within the template. Thus, the "web authoring" is performed by the seller.

Moreover, the "web authoring" described by Conklin is neither "offered for sale" nor within "a catalog of professional services," as also recited in the claims. Instead, the "web authoring" is just a portion of the registration process for being a participant in the sponsored community.

Still further, Conklin fails to teach that "brokering" of the "web authoring" occurs given the ordinary meaning of the term "brokering," attributed to it by one having ordinary skill in the art (i.e., a third party that assists in consummating a transaction between two other parties). Conklin does not teach brokering a professional service (i.e., allegedly disclosed by the "web authoring" of Conklin because, even if the "registration process" is considered to be a separate party although the seller performs the registration process, there are only two parties involved: the seller and the "registration process." Thus, no brokering occurs.

The Examiner's arguments extensively rely upon the finding that Conklin teaches brokering professional services using the same entity that manages certain sales functions for virtual store operators. However, as argued above, Conklin is silent with regard to this limitation. Therefore, one having ordinary skill in the art would not have arrived at the claimed invention based upon the combination of Conklin, Horn, and Vega.

Instead, if Conklin, Horn, and Vega were to combined in the manner suggested by the Examiner, a Global Store 1500 (i.e., the teachings of Horn) would be employed to provide the sales functions for virtual store operators and a separate retaining engine system 102 (i.e., the teachings of Vega) would be employed to provide services from a plurality of service providers. In contrast, in the claimed invention, the functions are combined into a single "e-business complex."

As discussed in M.P.E.P. § 2141, one of the basic considerations for an Examiner is to consider the claimed invention as a whole.¹ As already noted, the claimed invention, as a whole, is directed to combining these separate and distinct functions into a single entity. However, the claimed invention, as a whole, is not taught or suggested by the applied prior art since the applied prior art does not provide any motivation to combine these separate and distinct functions into a single entity. Applicants, therefore, respectfully submit that the rejection of claims 4, 7-8, and 11 under 35 U.S.C. § 103 for obviousness based upon Conklin in view of Horn and Vega is not viable.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the

¹When applying 35 U.S.C. § 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

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prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 21, 2006

Respectfully submitted,

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